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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,125	10/15/2003	Joseph D. Shropshire	8481-001	7641

7590

09/20/2004

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,125

Applicant(s)

SHROPSHIRE ET AL.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/30/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 12/30/2003 – IDS;
07/09/2004 – Revocation of Power of Attorney and Appointment of New Power of
Attorney.

Claims 1-17 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 7 and 10 are rejected under 35 U.S.C. 102(b) as being
anticipated by Costello ('820). As to claim 1, Costello includes a shaft (2) having a grip
(4) at an upper end. A club head (6) includes a rim (7) that defines a ball striking face
perimeter, with an aperture centered within the ball-striking face and sized to accept a
golf ball sized object (9). As to claim 2, the club head may include metal (page 1, col. 2,
line 97). As to claim 5, the ball-capturing cavity shown in Costello is indeed "molded" or
shaped to form an open-ended container. As to claims 6 and 7, considering that the
golf ball (9) in Costello is "officially sized", as broadly as claimed, the recess or ball-

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capturing cavity is sized with an opening that is slightly larger than the golf ball and further includes a rear end portion of minimum dimension that is slightly smaller than the golf ball, whereby the golf ball is lodged within the recess. As to claim 10, the sides, rear and top of the main club head body may include leather or fabric or other suitable material that retains the bag shape of the ball-capturing container and is thus deemed to include an elastically deformable surface against which the ball is trapped.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costello ('820) in view of Ezawa. The patent to Costello is silent concerning the volume of weight of the club head. In order to more closely approximate the size and weight of a golf club head that, for example, is used in regulation play, one skilled in the art would have found it obvious to modify the device in Costello at the time of applicant's invention by providing a weight and volume as claimed, since these parameters are well known in the art of hollow club heads, as taught by Ezawa. See col. 2, lines 25-33 in Ezawa.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costello ('820) in view of Gentiluomo and Nesbitt. To have simply replaced the golf ball (9) in the Costello device with a restricted flight golf ball fabricated from an elastomeric material in order to control the flight distance of a struck ball would have been obvious in view of the patents to Gentiluomo and Nesbitt, which show it to be old in the art to use a golf ball having restricted flight properties for the purpose of controlling the trajectory of a struck ball. Note the summary provided with each of Gentiluomo and Nesbitt.

Claims 11-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costello ('820) in view of Kibamoto. To have further modified the device in the cited art reference to Costello by including a practice mat along with a rubber tee simply to mimic the conditions of a fairway and a tee on a regulation golf course would have been obvious in view of the patent to Kibamoto, which shows it to be old in the art to fashion a practice matt from artificial turf and further include a rubber tee atop which a practice golf ball rests so that a golfer may practice teeing up the golf ball and swinging a club across the turf to simulate the actual address and swing that a golfer would normally face on a real grass-filled golf course. At the same time, the use of an artificial turf mat makes practice more comfortable than simply placing a golf ball on the bare ground (i.e., on concrete or other hard surface). The artificial turf will actually serve to cushion the shock transmitted to a golfer in the event that the club is swung and hits the ground before hitting the ball. See col. 3, lines 3-33 in Kibamoto. Specific to claim 17, given the modified device in Costello, the method steps flow logically and directly from the Costello reference, as the club in Costello is indeed swung so that the golf ball is trapped within the ball-capturing section, thereby signaling that a proper swing has been initiated.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costello ('820) in view of Hull. Costello lacks a ball extraction tool. Note, in the case of Costello, a golfer would have been able to and found it obvious to simply dislodge a golf ball from the ball-capturing device using one's finger. Nonetheless, Hull shows it to be old in the art to provide a supplemental device in the shape of an elongated rod

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fashioned to interact with an aperture in a golf club head so that a ball lodged within the head may be extracted. The rod or extraction tool is seen to be merely a convenient accouterment. Obviously, the shape and location of the rod would have depended on the general shape of the club head. It would have made sense to place the rod and its associated opening to the rear of the club head in the Costello device, for example, when one considers that the ball would have become lodged from the front of the head toward the rear of the head.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "officially-sized" used throughout the claims to describe the golf ball parameters can not be thoroughly comprehended, as the applicant has not provided a definition in the specification by which this phrase may be interpreted. Note, standards and conventions may be modified over the years. What may be deemed a standard or official size for a golf ball or a club head may change over the years, thereby making the meaning of the claimed language vague and difficult to interpret. As noted, there is no way of understanding what is or is not an official size.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kideney and Ring show ball catching devices, of interest. Kindling and Hawkins show ball retrieval elements, of interest.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
September 16, 2004